

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed July 6, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claims 4, 11, and 18 have been rejected under 35 U.S.C. § 112, first paragraph, for purportedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed.

The purpose of the written description requirement of 35 U.S.C. § 112, first paragraph, is to ensure that the inventor had *possession*, as of the filing date of application relied upon, of the specific subject matter later claimed by him. *Application of Wertheim*, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976); *Application of Edwards*, 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CCPA 1978). This possession requirement ensures that the applicant actually invented the later claimed subject matter at the time the patent application was filed. As stated by the Court of appeals for the Federal Circuit (hereinafter "Federal Circuit"):

Satisfaction of the description requirement ensures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that a *prima facie* date of invention can fairly be held to be the filing date of the application.

Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ 2d 1467, 1470 (Fed. Cir. 1995).

With possession being the key to satisfying the written description requirements of 35 U.S.C. § 112, first paragraph, the test for establishing that adequate written description simply concerns showing evidence that such possession existed. As has been repeatedly stated by both the Court of Customs and Patent Appeals and the Federal Circuit:

[A]ll that is required is that it [the applicant] *reasonably conveyed* to persons skilled in the art that, as of the filing date thereof, the inventor had *possession* of the subject matter later claimed by him.

Eiselstein, 52 F.3d at 1039, 34 USPQ2d 1467, 1470 (emphasis added).

Given that the claims themselves constitute part of the specification (*In re Dossel*, 115 F.3d 942 (Fed. Cir. 1997)) (“Focusing in on paragraphs 1 and 2, paragraph 1 states that ‘the specification shall contain a written description of the invention . . .’; paragraph 2 states that ‘the specification shall conclude with one or more claims.’ The statute thus makes clear that under current law the specification of a patent consists of, and contains, both a written description of the invention and the claims.”)), anything described in the originally claims satisfies the written description requirement of 35 U.S.C. § 112, first paragraph.

In the present case, Applicant clearly had possession of the claim elements of claims 4, 11, and 18 in that this material was present in those claims as originally filed. Accordingly, Applicant respectfully submits that the written description requirement of 35 U.S.C. § 112, ¶ 1 has been satisfied for this claim limitation.

II. Claim Rejections - 35 U.S.C. § 102(e)

Claims 1, 3, 6-8, 10, 13-15, 17, and 20 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Hayward, et al. ("Hayward," U.S. Pat. No. 6,629,134). Applicant respectfully traverses this rejection.

As noted above, each of Applicant's independent claims has been amended. In view of this fact, Applicant respectfully submits that the rejection is moot as having been drawn against Applicant's claims in a previous form. Applicant discusses the applicability of Hayward to Applicant's claims in the following, however, for the Examiner's consideration.

A. The Hayward Disclosure

Hayward discloses web-based user support. More specifically, Hayward discloses a computer program that executes on a computer that responds to conditions that are sensed by a peripheral. Hayward, column 1, lines 26-30. In operation of the peripheral, a "peripheral condition" may occur that indicates a need to replace a consumable. Hayward, column 5, lines 10-13. In such a case, "the peripheral condition is sent" by firmware to an application running on a computer 30, which indicates the condition to the user on a display of the computer. Hayward, column 5, lines 14-18.

The user is provided with the option of ordering the consumable. Hayward, column 6, lines 1-4. Specifically, when the user selects a "buy now" button from the computer, the application program launches a browser to access a purchase order screen, which the user can fill out. Hayward, column 7, line 66 to column 8 line 15. Once the user has filled out the purchase order screen, the browser either sends the purchase order to the manufacturer's server, or launches an e-mail module to send the purchase order data to the manufacturer's server. Hayward, column 8, lines 15-20.

B. Applicant's Claimed Inventions

Applicant claims methods, articles of manufacture, and control systems that pertain to status of a hard copy output engine. Applicant discusses these claims in the following.

1. Claims 1-7

Applicant's independent claim 1 provides as follows (emphasis added):

1. A method of scheduling an event with respect to a hard copy output engine, comprising:

detecting a first status of a first portion of the hard copy output engine from a first sensor incorporated in the hard copy output engine;

detecting a second status of a second portion of the hard copy output engine from a second sensor incorporated in the hard copy output engine;

automatically composing an electronic message without human intervention, the message including both the detected first and second status; and

automatically transmitting the electronic message over a network without human intervention.

As a first matter, Applicant notes that Hayward does not disclose “automatically composing an electronic message without human intervention” as is required by claim 1. To the contrary, as is described above, Hayward teaches a system in which the user is provided with the option of ordering a consumable. It is only when the user manually selects a “buy now” button from the computer when any electronic message is created by the “application” running on the user's computer. Accordingly, Hayward fails to anticipate claim 1 for at least this reason.

Applicant further notes that Hayward does not disclose automatically composing an electronic message that includes “both the detected first and second status” as is also required by claim 1. Although Hayward describes sending messages about a “peripheral condition,” Hayward is silent about sending a message regarding multiple detected statuses. As is noted in Applicant’s specification, this distinction is significant. In particular, “coordination of orders for supplies can be very helpful to avoid over or under-stocking of these consumable commodities, while still achieving the benefits of economies of scale.” Applicant’s specification, page 2, lines 10-11.

As a further matter, Applicant notes that Hayward does not disclose “automatically transmitting the electronic message over a network without human intervention” as is required by claim 1. Instead, as is noted above, it is only when the user manually selects a “buy now” button from the computer when any electronic message is created by the “application” running on the user’s computer. Accordingly, human intervention is required in Hayward’s system.

With particular regard to dependent claim 3, Applicant notes that Hayward further does not teach “detecting a future need for preventative maintenance”. Although Hayward describes detection of certain “conditions,” none of those conditions are described as indicating that any measure should be taken for “preventative maintenance” of the peripheral. Instead, Hayward is only concerned with conditions that pertain to replacement of a consumable that is exhausted or near exhaustion.

2. Claims 8-14

Applicant's independent claim 8 provides as follows (emphasis added):

8. An article of manufacture comprising a computer usable medium having computer readable code embodied therein to cause a processor to:

detect a first status of a first portion of the hard copy output engine from a first sensor incorporated in the hard copy output engine;

detect a second status of a second portion of the hard copy output engine from a second sensor incorporated in the hard copy output engine;

automatically compose an electronic message without human intervention, the message *including both the detected first and second status*; and

automatically transmit the electronic message over a network without human intervention.

As is described above, Hayward does not teach “automatically composing an electronic message without human intervention” that includes “both the detected first and second status”, or “automatically transmitting the electronic message over a network without human intervention”. It logically follows, therefore, that Hayward does not teach computer readable code that causes a processor to “automatically compose an electronic message without human intervention, the message including both the detected first and second status” or “automatically transmit the electronic message over a network without human intervention” as are required by independent claim 8. Accordingly, Hayward does not anticipate claim 8.

Regarding dependent claim 10, Applicant notes that Hayward further does not teach code that causes a processor to “detect a future need for preventative maintenance”, for reasons discussed above in relation to claim 3.

3. Claims 15-20

Applicant’s independent claim 15 provides as follows (emphasis added):

15. A computer implemented control system for a hard copy output engine, the system comprising:

a first sensor coupled to a first portion of the hard copy output engine, the first sensor being configured to provide a first status of the first portion;

a second sensor coupled to a second portion of the hard copy output engine, the second sensor being configured to provide a second status of the second portion; and

processor coupled to the first and second sensors and configured to:

detect the first status;

detect the second status;

automatically compose an electronic message without human intervention, the message including both the detected first and second status; and

automatically transmit the electronic message over a network without human intervention.

Regarding claim 15, Hayward does not teach a control system including a processor configured to “automatically compose an electronic message without human intervention, the message including both the detected first and second status” or

“automatically transmit the electronic message over a network without human intervention”, for reasons described above in relation to claims 1 and 8.

Furthermore, Hayward does not teach a processor that is configured to “detect a future need for preventative maintenance”, for reasons described above in relation to claims 3 and 10.

III. Claim Rejections - 35 U.S.C. § 103(a)

A. Rejection of Claims 2, 9, and 16

Claims 2, 9, and 16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayward in view of Haines, et al. (“Haines,” U.S. Pat. No. 6,233,409). Applicant respectfully traverses this rejection.

As an initial matter, Applicant notes that the Haines reference, which qualifies as prior art through 35 U.S.C. § 102(e), was, at the time the invention was made, owned by or subject to an obligation of assignment to the same entity, i.e., the Hewlett Packard Company. Given this fact, the Haines reference is not properly citable against Applicant’s claims in a rejection under 35 U.S.C. § 103 (see MPEP §706.02(I)). For this reason, Applicant respectfully requests that the rejection be withdrawn.

Even assuming, arguendo, that the Haines reference were properly citable against Applicant’s claims, Applicant notes that Haines does not remedy the deficiencies of the Hayward reference described above. Therefore, Applicant respectfully submits that claims 2, 9, and 16, which depend from claims 1, 8, and 15, respectively, would be allowable over the Hayward/Haines combination for at least the same reasons that claims 1, 8, and 15 are allowable over Hayward.

B. Rejection of Claims 4-5, 11-12, and 18-19

Claims 4-5, 11-12, and 18-19 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayward in view of Haines, and further in view of Sekizawa (U.S. Pat. No. 6,681,349). Applicant respectfully traverses this rejection.

As a first matter, Applicant again notes that the Haines reference is not properly citable against Applicant's claims. Even assuming, arguendo, that it were, the Hayward/Haines/Sekizawa combination would not render Applicant's claims 4-5, 11-12, and 18-19 obvious given that Sekizawa does not remedy the aforementioned deficiencies of the Hayward and Haines references.

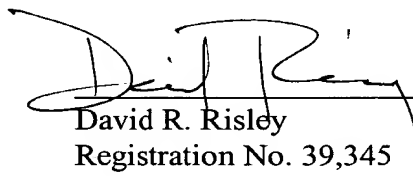
IV. New Claims

As identified above, claims 21-31 have been added into the application through this Response. Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

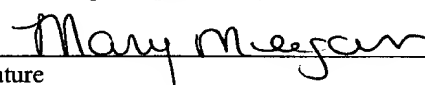
CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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